

Remarks

Upon entry of the foregoing amendment, claims 1-11, 16-18, 21-25, 27-31, 55-57, 61-63, and 66-70 are pending in the application, with 1, 31, 55 and 67 being the independent claims. Claims 1, 29, 31, 55-57, and 61-63 have been amended. New claims 67-70 are sought to be added. Support for the claim amendments and new claims may be found in the original claims and throughout the specification, for example at paragraph 62 and Figure 8A of the published application. Thus, no new matter is added by way of these claim amendments and addition of new claims, and their entry is respectfully requested.

In view of the above amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-11, 16-18, 21-25, 27-31, 55-57, 61-63, and 66 are rejected under 35 U.S.C. § 112, first paragraph as being non-compliant with the written description requirement. The Office Action states that the recitation of “multi-layer filter” in claims 1, 31, and 55 is not supported by the specification and raises the issue of new matter. See Office Action at page 3. Applicants respectfully traverse.

To satisfy the enablement requirement of 35 U.S.C. § 112, first paragraph, an application must disclose the claimed invention in sufficient detail to enable a person of ordinary skill in the art to make and use the claimed invention. According to the MPEP, the subject matter of the claim need not be described literally (*i.e.*, using the same terms or *in*

haec verba) in order for the disclosure to satisfy the description requirement. See MPEP 2163.02, 8th Edition Revision 5).

The present specification discloses a filter that preferably “comprises one or more filter layers” See paragraph [0059] of the published application. Skilled artisans would necessarily recognize from the given disclosure that a filter having “one or more filter layers” includes, for example, those filters having two filter layers, three filter, four filter layers, etc. or, in other words, filters having multiple layers. Thus, a multi-layer filter is described in the specification, albeit not *in haec verba*.

However, simply to expedite allowance, the present claims have been amended to no longer recite “multi-layer filter,” thus rendering the rejection moot. Therefore, the specification is fully compliant with the written description requirement of 35 U.S.C. § 112, first paragraph and Applicants respectfully request that the rejection of claims 1-11, 16-18, 21-25, 27-31, 55-57, 61-63, and 66 be withdrawn.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-11, 16-18, 21-25, 27-31, 55-57, 61-63, and 66 are rejected under 35 U.S.C. § 102(b) as being anticipated by Jones (PCT WO95/02049). Applicants respectfully traverse.

An anticipation rejection under 35 USC § 102 requires a showing that each limitation of a claim is found in a single reference, practice, or device. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984). The test for anticipation is one of strict identity. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002). “Though anticipation is the epitome of obviousness,

[they] are separate and distinct concepts” See Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984).

The present claims are drawn to methods for isolation of biological macromolecules or DNA. The claimed methods involve contacting a filter with a biological sample or cell lysate, wherein the filter comprises two filter layers, and wherein the filter comprises a first filter layer and a second filter layer that are in contact with each other.

Jones does not disclose a filter that comprises a first filter layer that is in contact with a second filter layer. Jones discloses two filters separated by a conduit and a chamber (see Jones page 22 and corresponding figure 5; structures 47 & 48). Accordingly, Jones does not anticipate the present claims and Applicants therefore, request that the rejection of claims 1-11, 16-18, 21-25, 27-31, 55-57, 61-63, and 66 under 35 U.S.C. § 102(b) be withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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